REMARKS

Claims 1-10 are pending and under examination. Claims 1 and 7 have been amended merely to clarify the sequencing of the steps. The amendments are not narrowing. New claims 11 and 12 are presented herewith. This response is being filed together with a Request for Continued Examination.

The Claims are Patentable Over Bois in View of Tomic

Claims 1-10 stand rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Bois (U.S. Patent No. 6,085,491) ("Bois") in view of Tomic (U.S. Patent No. 6,386,760) ("Tomic"). Applicants respectfully traverse the rejection.

Applicant maintains that the skilled artisan would not have been motivated to combine the cited references. The Office Action cites *In re Keller* to support the notion that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in art. Applicants do not argue that the measure of obviousness includes all that properly combined references teach, however, there must an initial motivation to combine the references. Here, such a motivation is completely lacking and the combination requires the entire operating principle of one or both references to be ignored. Particularly, the Office Action has not provided any objective reason why a skilled artisan would have been motivated to combine the references in the manner suggested. As the Board of Appeals recently stated in *Ex parte Gottling* (B.P.A.I. 2005):

> Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Here, as in that case, there was no suggestion in the prior art itself as to the desirability of the modifying the teachings of one reference with those of the other. Additionally, neither reference specifically recognized or appreciated the advantages of Applicant's claims.

Notwithstanding the foregoing, Applicants have amended their claims to advance prosecution. The Office Action alleges that the claims do not recite the sequential attachment steps as presented in Applicant's prior response. The sequential steps are now clearly reflected in the express language of the claim. Such methods and related apparatus are neither taught nor suggested by the Bois or Tomic references, nor any combination, suggested or not, thereof.

It was agreed that Bois does not teach or suggest any body of a fastener which is free for movement at all. Tomic does not teach or suggest the express limitation of the method of claim 1 of Applicant's invention wherein the fastener is ***first*** attached to the substrate so as to leave the body of the fastener free for movement relative to the substrate, and the fastener is ***subsequently*** attached to the substrate so as to seal the substrate to the fastener body. Accordingly, the combination of Bois and Tomic does not teach or suggest each and every limitation of the claimed invention. Thus, the invention is patentable over the combination.

In view of the foregoing, reconsideration is respectfully requested, with the resultant withdrawal of the rejection under 35 U.S.C. § 103(a).

Conclusion:

This amendment and the associated remarks are believed to be fully responsive to the outstanding Office Action. Applicant respectfully asserts that the claimed invention is plainly distinguished over the cited art and that all claims are in condition for allowance.

An early and favorable Notice to that end is earnestly solicited. The examiner is invited to address any outstanding issues prior to allowance with the Applicant's undersigned representative who may be reached at 215-557-5986 or by facsimile at 215-568-3439.

Respectfully submitted,

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